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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Emrys J. Williams

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EXAMINER

AGWUMEZIE, CHARLES C

ART UNIT

PAPER NUMBER

3685

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/654,733	<b>Applicant(s)</b> WILLIAMS, EMRYS J.	
	<b>Examiner</b> CHARLES C. AGWUMEZIE	<b>Art Unit</b> 3685	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-2, 4-10, 12-31, 33-37 and 39 is/are pending in the application.
- 4a) Of the above claim(s) 15-16, 17-25, 30-35, 36-37 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-10, 12-14, and 26-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/22/03</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 14, 2008 has been entered.

### ***Acknowledgment***

2. Applicants' amendment filed July 14, 2008 is acknowledged. Accordingly claims 1-10, 12-31, 33-37, and 39 remain pending. Applicant provisionally elect Group I: claims 1-8, 9-14, and 26-29 with traverse via telephone discussion with Robert Kowert on October 10, 2008.

### ***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. **Claims 1-8, 9-14, and 26-29**, drawn to an apparatus for use in transaction, comprising non-volatile memory containing a set of multiple identifiers associated with a same customer account...classified in class 705, subclass 75.

- II. **Claim 16**, drawn to an apparatus for use in making transaction, including a processor operable to randomly or pseudo-randomly select one identifier from said set of multiple identifiers for use in any transaction, classified in class 705, subclass 65.
- III. **Claims 15, 17-25, 30-35, 36-37 and 39**, drawn to a method comprising opening an account record in an agency computer system, wherein said agency is to provide the account, receiving a public key from the portable transaction device, receiving a transaction record comprising a digital signature from the portable transaction device, classified in class 705, subclass 67

The inventions are distinct, each from the other because of the following reasons:

4. Inventions I, II, and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable (MPEP § 806.05 (c)). In the instant case, invention I has separate utility such as a non-volatile memory containing a set of multiple identifiers associated with a same customer account.... Invention II has separate utility such as a processor operable to randomly or pseudo-randomly select one identifier from said set of multiple identifiers for use in any transaction. Invention II has separate utility such as opening an account record in an agency computer system, wherein said agency is to provide the account, receiving a public key from the portable

transaction device , receiving a transaction record comprising a digital signature from the portable transaction device.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because the search required for one group is not required for another group, restriction for examination purposes as indicated is proper.

Accordingly, **Claims 15-16, 17-25, 30-35, 36-37 and 39**, withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Groups II and III, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in a telephone discussion with Robert Kowert on October 10, 2008.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claim 14**, is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, it would be unclear to one of ordinary skill in that art to understand the technical meaning of “for a given period of time, limiting the number of performed transactions, prevent rapid readout of the identifiers.” How does the apparatus performs this operation in the first place? Is it when the apparatus is being used or what?

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-2, 5, 7-10, 13, and 26-29**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al U.S. Patent Application Publication No. 2006/0218098 A1 in view of Pitroda U.S. Patent Application No. 2005/0247777A1.

10. As per **claims 1, 9, and 26**, Walker et al discloses an Apparatus for use in transactions, comprising:

non-volatile memory containing a set of multiple identifiers associated with a same customer account, wherein said multiple identifiers are also known to an agency providing said customer account (fig. 1; 0025; 0026; "...plurality of predetermined single-use financial account identifiers..."), and

a processor operable to select for each of a plurality of transactions involving the same customer account, a different identifier from said set of multiple identifiers for use with the respective transaction (fig. 1; 0023; 0047; 0049; "...the encryption data changes for each use of the card so that ... card number is different for each transaction...") and

a communications facility operable to communicate with a terminal (0004; ...wireless connection...; 0047; cardholder transmits the single use number to merchant...; );

wherein the apparatus is operable to:

receive bill details for a given transaction of said plurality of transactions from the terminal through the communications facility,

generate a transaction record from the bill details, wherein the transaction record includes a particular identifier selected by the processor from said set of multiple identifiers; and

transmit the transaction record to the terminal through the communications facility (figs. 3 and 4; 0045; 0047; "...transmits the single use number to the merchant...").

**11.** What Walker et al does not explicitly disclose is:

wherein the apparatus is operable to:

receive bill details for a given transaction of said plurality of transactions from the terminal through the communications facility,

generate a transaction record from the bill details, wherein the transaction record includes a particular identifier selected by the processor from said set of multiple identifiers; and

transmit the transaction record to the terminal through the communications facility.

**12.** Pitroda discloses an apparatus for use in transaction comprising:

receive bill details for a given transaction of said plurality of transactions from the terminal through the communications facility (0089, which discloses that the point of sales computer will download and display the transaction details, as shown in FIG. 16, and transmit the transaction information into the memory of the UET card, on which the transaction information may be displayed for visual verification by the customer; 0100);

generate a transaction record from the bill details, wherein the transaction record includes a particular identifier selected by the processor from said set of multiple identifiers (0089; 0100, which discloses “transmits completed details of the sales transaction to the point of sales computer, the UET card, and the American Express service... the details include the date of the transaction, the amount, the name of the retail store or service (for the UET card and the American Express service records), the name of the customer (for the American Express and point of sales computers); and

transmit the transaction record to the terminal through the communications facility (0100, which discloses transmits completed details of the sales transaction to the point of sales computer).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the apparatus, wherein the apparatus is operable to: receive bill details for a given transaction of said plurality of transactions from the terminal through the communications facility, generate a transaction record from the bill details, wherein the transaction record includes a particular identifier selected by the processor from said set of multiple identifiers; and transmit the transaction record to the terminal through the



communications facility in view of the teachings of Pitoda, since the claimed invention is merely a combination of old and known elements, and in the combination each element would merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**13.** As per **claim 2, and 10**, Walker et al further discloses the apparatus, wherein each of the identifiers in said set of multiple identifiers is allocated by the agency uniquely to the apparatus (figs. 1 and 10; 0049; 0093; "...instructing card holder to obtain a new device with list of single-use credit card numbers...").

**14.** As per **claim 5 and 13**, Walker et al further discloses the apparatus, wherein the transaction record is encrypted (0009; 0023).

**15.** As per **claim 7**, Walker et al further discloses the apparatus, wherein said apparatus is operable to engage a first class of terminals external to the apparatus for making a transaction, and a second class of terminals external to the apparatus to enter or to update account information stored in the non-volatile memory (fig. 3 and 4; 0093).

**16.** As per **claim 8**, Walker et al failed to explicitly disclose the apparatus, further comprising first and second power circuits that are activated by said first and second class of terminals respectively, wherein activation of said second power circuit does not

allow account information to be entered or updated in at least certain portions of said non-volatile memory.

Pitroda discloses the apparatus, further comprising first and second power circuits that are activated by said first and second class of terminals respectively, wherein activation of said second power circuit does not allow account information to be entered or updated in at least certain portions of said non-volatile memory (see figs. 3; 0014).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the apparatus, further comprising first and second power circuits that are activated by said first and second class of terminals respectively, wherein activation of said second power circuit does not allow account information to be entered or updated in at least certain portions of said non-volatile memory in view of the teachings of Pitroda since the claimed invention is merely a combination of old and known elements, and in the combination each element would merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**17.** As per **claim 27**, Walker failed to explicitly disclose the method, wherein the transaction record includes a digital signature from the transaction device.

Pitroda discloses the method, wherein the transaction record includes a digital signature from the transaction device (0089; 0100)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the method, wherein the transaction record includes a digital signature from the transaction device in view of the teachings of Pitroda since the claimed invention is merely a combination of old and known elements, and in the combination each element would merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**18.** As per **claim 28**, Walker further discloses the method, wherein the transaction device is associated with a customer account, and wherein said multiple identifiers are also known to an agency providing said customer account, but failed to explicitly disclose the method further comprising:

- transmitting the transaction record from the terminal to an agency computer;
- accessing an account record for the customer account based on the selected identifier included in the transaction record;

- validating the transaction and

- updating the account record in respect of the validated transaction.

Pitroda discloses the method further comprising:

- transmitting the transaction record from the terminal to an agency computer (0100, which discloses the CIU transmits completed details of the sales transaction to the point of sales computer, the UET card, and the American Express service);

accessing an account record for the customer account based on the selected identifier included in the transaction record (0100);

validating the transaction (0099; 0100) and

updating the account record in respect of the validated transaction (0099; 0100).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the apparatus comprising, transmitting the transaction record from the terminal to an agency computer; accessing an account record for the customer account based on the selected identifier included in the transaction record; validating the transaction and updating the account record in respect of the validated transaction in view of the teachings of Pitroda, since the claimed invention is merely a combination of old and known elements, and in the combination each element would merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**19.** As per **claim 29**, Walker failed to explicitly disclose the method, wherein prior to transmitting the transaction record from the terminal to the agency computer, the terminal incorporates its own copy of the bill into the transaction record.

Pitroda discloses the method, wherein prior to transmitting the transaction record from the terminal to the agency computer, the terminal incorporates its own copy of the bill into the transaction record (0089; 0100).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Wynn and incorporate the method, wherein prior to transmitting the transaction record from the terminal to the agency computer, the terminal incorporates its own copy of the bill into the transaction record in view of the teachings of Pitroda, since the claimed invention is merely a combination of old and known elements, and in the combination each element would merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**20. Claims 4 and 12**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al U.S. Patent Application Publication No. 2006/0218098 A1 in view of Pitroda U.S. Patent Application No. 2005/0247777A1 and further in view of Ritter et al U.S. Patent No. 6,934,689.

**21.** As per **claim 4 and 12**, both Walker et al and Pitroda failed to explicitly disclose the apparatus, wherein the transaction record includes a digital signature that is generated using a cryptographic key contained within the non-volatile memory.

**22.** Ritter et al discloses the apparatus, wherein the transaction record includes a digital signature that is generated using a cryptographic key contained within the non-volatile memory (col. 2, line 60- col. 3, line 10, which discloses that the payment request of the payment transaction being transmitted from the payment terminal to the mobile

device taking part in the respective payment transaction ... a payment record being prepared in the mobile device in that the payment is linked to a customer identification ... for example is provided with an electronic signature of the customer or is executed as a secured certificate ... the payment record being transmitted from the mobile device to the payment terminal ...).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the apparatus, wherein the transaction record includes a digital signature that is generated using a cryptographic key contained within the non-volatile memory in view of the teachings of Ritter, since the claimed invention is merely a combination of old and known elements, and in the combination each element would merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable

**23. Claims 6**, is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al U.S. Patent Application Publication No. 2006/0218098 A1 in view of Pitroda U.S. Patent Application No. 2005/0247777A1 and further in view of Palomo et al U.S. Patent Publication No. 2003/0120527 A1.

**24.** As per **claim 6**, both Walker et al and Pitroda failed to explicitly disclose the apparatus, wherein said apparatus is provided within inert packaging to allow implantation into the human body.

**25.** Palomo et al discloses the apparatus, wherein said apparatus is provided within inert packaging to allow implantation into the human body (0025, which discloses that '741 patent describes a computer system and method for storage of individual medical histories ... the size of which is that of a credit card including the possibility of implanting the storage device under the skin of the patient's upper torso).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the apparatus, wherein said apparatus is provided within inert packaging to allow implantation into the human body as taught by Palomo et al since the claimed invention is merely a combination of old and known elements, and in the combination each element would merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

### ***Conclusion***

**26. Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of

the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Charles C.L. Agwumezie** whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on **(571) 272 – 6709**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charlie C Agwumezie/  
Primary Examiner, Art Unit 3685  
October 10, 2008